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| 10/539,255 | 05/01/2006 | Jorgen Glaesel | 2081-0134PUS1 | 2445 |
| 2292 7590 08/19/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747 | | | | |
| EXAMINER MCEVOY, THOMAS M | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3731 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/539,255

Applicant(s)

GLAESEL, JORGEN

Examiner

THOMAS MCEVOY

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/22)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 April 2010 has been entered.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-9 and 11-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. In claim 1, it is unclear what a thickness of a cutter blade may be when it is supposed to be "less than a size of a head of a tick". For examination purposes, the examiner assumes that the thickness is relatively thin. Correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-6, 9 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browne (US 549,895) in view of Gobeil et al. (US 5,884,900).

Regarding claim 1, Browne discloses a tool capable of removing ticks and other like parasites from the skin (a tack shank can be comparable in size to a tick), which tool has an engagement part ($a/a'/a^2$) with a bottom face and a top face (Figure 4), wherein a V-shaped groove (Figure 3) is provided that has side faces (Figure 2) between the bottom face and the top face at an edge (Figure 4; perpendicular to concave side faces) of the engagement part, which side edges converge towards each other from an outer opening at the edge towards an internal assembly point a^2 , said V-shaped groove being wider at the top face of the engagement part than it is at the underside (Figure 4), characterised in that a considerable portion of each side face of the V-shaped groove between the underside and the top face of the engagement part is constituted by a concave engagement face (Figure 4). At the bottom of the V-shaped groove, at a^2 of Figure 2, what can be regarded as a cutter blade is provided in level with the bottom face (see line 88). Browne fails to disclose the blade thickness as claimed. Gobeil et al. teach that the thickness of a fastener remover should be less than the length of a tick head (see attached references cited) in order to wedge the device under the top of the fastener (col. 2, lines 65-67;

Figures 4-6). Therefore, it would have been obvious to one of ordinary skill in the art in view of Gobeil et al. to have constructed all portions of the Browne device that are intended to wedge under a tack head with the claimed thickness. This would include the bottom of the V-shaped groove. Regarding claim 2, a lowermost part of the concave engagement face is essentially in parallel with the bottom face (Figure 4). Regarding claims 3-5, the concave face can be regarded in the claimed manners. Regarding claim 6, each side face comprises a lowermost part (Figure 4; wall between side face and bottom face) that extends essentially perpendicularly from the bottom face and is connected to the concave engagement face. Regarding claim 9, an innermost part of the lowermost part of the side face is provided with parallel side faces (Figure 4). Regarding claim 11, the tool comprises a holder part C' provided with an upwardly protruding transverse beam B for supporting a thumb. Regarding claim 12, the tool comprises a holder part C' provided with an indentation (at C', Figure 1) for supporting a thumb. Regarding claim 14, a/a'/a2 forms a recess that can support a finger. Regarding claims 13 and 17, Browne discloses the device as described above but fails to disclose ribs on the handle. However, it is well-known in the art to provide ribs on the handles hand tools to provide gripping support. It would therefore have been obvious to one of ordinary skill in the art to have provided a ribbed area on the handle of Browne to provide gripping support. Browne fails to disclose that the overall length (or the largest outer dimension) corresponds essentially to the dimensions of a credit card (3-4 inches). However, it is well-known in the art that small, hand-held prying instruments of this nature can have overall lengths of 3-4 inches (see References Cited). It would therefore have been obvious to one of ordinary skill in the art to have constructed the device with this overall length as an obvious matter of design choice. Since Applicant failed to traverse

examiner's assertions, the above well-known in the art statements (for claims 13 and 17) are taken to be admitted prior art (MPEP 2144.03 C). Regarding claim 15, part C of the tool is plate shaped. Regarding claim 16, at least one recess is provided in the area between the engagement part and the holder part (lines 77-83).

5. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browne (US 549,895) in view of Gobeil et al. (US 5,884,900) and Graue (US 1,101,845).

Regarding claims 7 and 8, Browne in view of Gobeil et al. discloses a tack remover which is capable of removing ticks as described above. Browne does not disclose that the lowermost part of the side faces is increasing in height as claimed. Graue discloses a tack puller which has side faces which increase in height (at item 6, Figures 1 and 3; lines 60-65). It would have been obvious to one of ordinary skill in the art in view of Graue to have increased the height of the Browne lowermost part as claimed because one of ordinary skill in the art would recognize that the tapering in height of Graue's V-shaped groove assists in wedging the tool under a tack. Examiner further contends that tapering the height of a v-shaped groove is old and well known in the art in order to wedge a tack or nail puller under a tack or nail head as evidenced by at least Benitez et al. (cited previously; additional references can be provided).

Response to Arguments

6. Applicant's arguments filed April 21st 2010 have been fully considered but are moot in view of the new grounds of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas McEvoy whose telephone number is (571)270-5034. The examiner can normally be reached on M-F, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas McEvoy/
Examiner, Art Unit 3731

/Anh Tuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731
8/14/10